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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,439	01/19/2001	Robert Betros	43416-0003	7164
33123	7590	09/04/2007	EXAMINER	
HELLER EHRLICH LLP 4350 LA JOLLA VILLAGE DRIVE #700 7TH FLOOR SAN DIEGO, CA 92122				FRINK, JOHN MOORE
ART UNIT		PAPER NUMBER		
2142				
MAIL DATE		DELIVERY MODE		
09/04/2007		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

170

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/766,439	BETROS ET AL.
	Examiner	Art Unit
	John M. Frink	2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1)  Responsive to communication(s) filed on 7/23/2007.
- 2a)  This action is FINAL.      2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4)  Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 1-21 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:
  1.  Certified copies of the priority documents have been received.
  2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 7/23/2007.
- 4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5)  Notice of Informal Patent Application
- 6)  Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Response to Declaration Under 37 CFR 1.132 (R. Betros)***

1. Applicant states that embodiments of the invention were reduced to practice before the preparation of the filing. No corroborating evidence was presented in support of this assertion. When the lack of corroborating evidence is considered along with Applicant's natural interest in obtaining a patent, the Examiner finds that this assertion has little probative value.
2. Applicant further states that within a few weeks following the application date, a product embodying the invention was offered for sale. However, this statement again is made without support from any corroborating evidence. Additionally, the referenced time is 'a few weeks following the application date,' rather than the more relevant actual application date. Furthermore, merely offering an item for sale does not prove its existence. Applicant's statements are thus given little weight.
3. Applicant also states that within seven months of the date of application, he had made sales of products embodying the invention. Again, this statement is made without corroborating evidence. Also, the referenced seven months following the application date is not germane as it is not the actual application date. Applicants statements are thus of little probative value and are given little weight.
4. Applicant concludes with an opinion regarding the level of experimentation required to make and use Applicant's invention, which cannot take the place of fact. Furthermore, given Applicant's inherent interest in obtaining a patent, Applicant's opinion in this matter is of little probative value.

5. Finally, Applicant's declaration only considers one of the *In Re Wands* factors, the quantity of experimentation needed to make or use the invention. Due the omission of the remaining *In Re Wands* factors, and the lack of corroborating evidence given for the single factor referenced, Applicant's declaration is of little probative value.

***Response to Declaration Under 37 CFR 1.132 (B. Tipler)***

6. Tipler, with whom Applicant has contracted with for an additional opinion, begins by addressing the breadth of the claims. However, this section is merely opinion, which cannot take the place of evidence, and a substantial repetition of the claims. Tipler's discussion of the breadth of the claims is thus of little probative value.

7. Tipler continues by addressing the nature of the invention, specifically stating that the HTTP specification was well known at the time of invention. However, the HTTP specification is not the invention, and the claimed subject matter is clearly includes elements other than HTTP, such as CGI. The referenced HTTP specification is silent regarding CGI. Tiper further states that the nature of the invention is a novel and non-obvious advancement in a well known field. However, the Office fails to see how this statement is germane to the claims.

8. Regarding the state of the prior art, Tiper continues to address the HTTP specification, which as was noted above, is not the invention. Furthermore, no specific claim elements are addressed, and thus the statements are of little probative value. Tiper concludes by stating that the state of the art related to HTTP communications was well developed. However, this is a general statement not linked to the claimed invention.

Tiper's other statements in this section are directed to the level of ordinary skill in the art and are thus addressed below.

9. Regarding Tiper's statements on the level of ordinary skill in the art, Tiper again addresses the HTTP specification, stating that internet programmers would need an in-depth understanding of at least the HTTP 1.0 specification to be functional in the art. However, these comments are irrelevant as the HTTP specification is not the invention, and the claimed subject matter clearly extends beyond the HTTP specification to areas with which the HTTP specification is silent, such as CGI. Furthermore, Tiper states that internet programmers were at the core of the 'dot com' era, which is a general statement not linked to the claimed invention, and not germane to the level of skill in the art. Tiper further states that the state of the art in HTTP programming was high, which again is a statement not linked to any specific claim elements. Tiper concludes by stating that in their opinion the level of skill in computer communications and particularly HTTP programming was high. However, opinions cannot take this place of evidence.

Thus, Tiper's statements are of little probative value.

10. Tiper addresses the level of predictability in the art by stating that programming is extremely predictable as computers execute the code provided. That computers execute provided code, and that the computer arts are generally considered predictable is not in question.

11. Regarding the amount of direction provided by the inventor, Tiper states that CGI programming was very well known at the time of the invention, and references a Gunavaram's 'CGI Programming on the World Wide Web' as support. However, said

reference is a discussion on CGI in general, not on the specific matters addressed by the claims, and thus is given little weight.

12. Regarding the quantity of experimentation needed, Tiper notes their opinion is that the quantity needed is very low. However, no evidence is given as support of this opinion, and thus it is of little probative value.

13. Tiper concludes with an opinion that the disclosure is enabling. However, this has little probative value as it does not appear to be supported by evidence.

#### ***Response to Arguments***

14. Applicant's arguments filed 7/23/2007 have been fully considered but they are not persuasive. Said arguments are a repetition of the arguments filed 12/04/2006, and the response to said arguments, mailed 4/19/2007, thus applies as well. Applicant's 37 CFR 1.132 declarations are discussed above.

#### ***Claim Rejections - 35 USC § 112***

15. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

16. Claims 1 – 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

17. The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation. *United States v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988). The factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue" include, but are not limited to: (a) the breadth of the claims; (b) the nature of the invention; (c) the state of the prior art; (d) the level of one of ordinary skill; (e) the level of predictability in the art; (f) the amount of direction provided by the inventor; (g) the existence of working examples; and (h) the quantity of experimentation needed to make or use the invention based on the content of the disclosure. *In re Wands*, 858 F.2d 731,737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). As to the breadth of the claims, the claims in this application are broad. Essentially all particular implementations for performing two-way asynchronous communication between a client and a server within a single HTTP transaction fall within the scope of the claims. Analysis of this factor therefore suggests that the amount of experimentation to make and use the invention is undue.

18. As to the breadth of the claims, the claims in this application are broad. Essentially all particular implementations for performing two-way asynchronous communication between a client and a server within a single HTTP transaction fall within the scope of the claims. After considering all of the evidence, analysis of this

factor therefore suggests that the amount of experimentation to make and use the invention is undue.

19. As to the nature of the invention, the applicants suggest that because the technology of computer networks has existed since the late 1960's, the nature of the invention suggests that the amount of experimentation is not undue. This argument is in one sense correct. Computer networks were known, in the 1960's. However, the examiner would point out that the subject matter of this application, HTTP based systems, was not known in the 1960's. Therefore, the fact that some of the basic underlying network technology may have existed for a long time does not seem germane to the question of more recent technology at issue here. After considering all of the evidence in the record, the examiner fails to see how this factor is probative of whether or not the amount of experimentation is undue.

20. As to the state of the prior art, the very features that the applicants argue distinguish the claims from the prior art are those that are not described. A search of the prior art has not disclosed a system as claimed for performing two- way asynchronous communication between a client and a server within a single HTTP transaction. Analysis of this factor and all of the evidence in the record therefore suggests that the amount of experimentation to make and use the invention is undue.

21. As to the level of skill in the art, there is no evidence in the record as to the level of skill in the art other than the applicants' assertion without evidence that the number of skilled people in the art was substantial and that their level of programming skills was high. Argument cannot take the place of evidence, and these statements therefore have

little probative value. After considering all of the evidence in the record, the examiner fails to see how this factor would suggest that the amount of experimentation to make and use the invention is either undue or not undue.

22. As to the level of predictability in the art, the computer arts are generally considered predictable. Analysis of this factor therefore suggests that the amount of experimentation to make and use the invention is not undue.

23. As to the amount of direction provided by the inventor, the applicants' attorney pointed to page 3 lines 12-25, page 6 line 11 to page 7 line 24, and page 8 line 12 to page 9 lines 12 in conjunction with the figures as supporting their amendments to the claims during the telephone interview held on June 15, 2006. During that interview, the inventor, Robert Betros, pointed to the client side logic (Fig. 1 elem. 104) and CGI (Fig. 1 elem. 124) in conjunction with Figures 2 and 4 as what implements the claimed invention. Given the inventor's statement in the interview, a review of the specification's disclosure regarding the client side logic and the CGI is important. The specification describes embodiments of dynamically delivered client side logic as applets and Macromedia Shockwave movies (p. 5 lines 10-13). However, the specification then states that these embodiments are merely exemplary and not limiting (p. 5 lines 10-13). The applicants are essentially saying that the client side logic is software. However, the application only describes generally the functions the client side logic performs but provides no details on the particular software constructs that would be used to implement those functions. The specification describes an embodiment of the CGI as being a servlet, but states that other embodiments are possible (p. 6 lines 3-4).

Although the specification generally describes the functions of the CGI, the specification provides no guidance on the specific software constructs that would be used to implement those functions. Analysis of this factor therefore and all of the other evidence in the record suggests that the amount of experimentation to make and use the invention is undue.

24. As to existence of working examples, the specification does not describe a working example. Analysis of this factor and all of the other evidence in the record therefore suggests that the amount of experimentation to make and use the invention is undue.

25. As to the quantity of experimentation needed, there is no evidence in the record indicate the quantity of experimentation that one of ordinary skill in the art would need to implement the present invention. Although the applicants have argued that no experimentation would be required, this statement is merely argument unsupported by any evidence, as discussed above. After considering all of the evidence in the record, the examiner fails to see how this factor would suggest that the amount of experimentation to make and use the invention is either undue or not undue.

26. After weighing all of the factors and all of the evidence in the record, the totality of the evidence suggests that it would require undue experimentation to make and use the claimed invention. The majority of the factors for which there is evidence suggest that undue experimentation is required. As to other factors, the evidence in the record is insufficient to establish whether undue experimentation would be required or not. See the discussion of the nature of the invention, the level of ordinary skill in the art, and the

quantity of experimentation above. Furthermore, although a patent need not teach, and preferably omits, what is well known in the art, *in re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987); and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1463, 221 USPQ 481,489 (Fed. Cir. 1984), the corollary to this statement is that a patent discloses more detail concerning the features that distinguish the claimed invention from the prior art. In this regard, the specification's lack of direction, which is discussed above, appears critical. In addition, the need for more description is consistent with the statement of Robert Betros, one of the inventors of the claimed invention, in the telephone interview on June 15, 2006, where he argued that the client side logic and CGI allow for the performing of two-way asynchronous communication.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Frink whose telephone number is (571) 272-9686. The examiner can normally be reached on M-F 7:30AM - 5:00PM EST; off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571)272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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